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| APPLICATION NO.                                 | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/532,064                                      | 01/12/2006  | Kanako Suzuki        | 050253              | 8965             |
| 23850                                           | 7590        | 03/08/2007           | EXAMINER            |                  |
| ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP |             |                      | VOGEL, NANCY S      |                  |
| 1725 K STREET, NW                               |             |                      | ART UNIT            | PAPER NUMBER     |
| SUITE 1000                                      |             |                      | 1636                |                  |
| WASHINGTON, DC 20006                            |             |                      |                     |                  |
| SHORTENED STATUTORY PERIOD OF RESPONSE          |             | MAIL DATE            | DELIVERY MODE       |                  |
| 3 MONTHS                                        |             | 03/08/2007           | PAPER               |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 10/532,064             | SUZUKI ET AL.       |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Nancy T. Vogel         | 1636                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 14 December 2006.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 4 and 6-8 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 4 and 6-8 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/14/06.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_.

**DETAILED ACTION**

Claims 4, and 6-8 are pending in the case.

Receipt of the Information Disclosure Statement on 12/14/06 is acknowledged.

***Response to Amendment***

Any rejection of record in the previous action not addressed in this office action is withdrawn. There are no new grounds of rejection that were not necessitated by applicants' amendment and therefore, this action is final.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 6, 7, 8 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4 and 6-8 are vague and indefinite in the recitation of "a promoter of α-amylase, glucoamylase, or α-glucosidase of *Aspergillus* acting on the structural gene" (claim 4 and 6) since it is not clear what is intended by this phrase. It is not clear whether the recited promoter is intended to be one of the promoters associated with the DNA or gene encoding the recited enzymes, or something else. It is noted that the art does not recognize a phrase such as "a promoter of glucoamylase" etc. as being the upstream DNA region responsible for the control of transcription, i.e. the promoter, of

the gene encoding the recited enzyme. Furthermore, the claims are vague and indefinite since it is not clear whether promoter recited in line 4 of claims 4 and line 3 of claim 6 is the same promoter which causes “expression is induced by isomaltose” in line 2. Furthermore, there is no antecedent basis for the recitation of “the structural gene” in line 4 of claims 4 and 6. Furthermore, it is not clear whether it is intended that “the structural gene” in lines 4 and 5 of claim 4 and lines 3 and 4 is the DNA encoding  $\alpha$ -amylase, glucoamylase, or  $\alpha$ -glucosidase, or whether only the promoters for the genes encoding these enzymes is intended.

#### ***Claim Objections***

Claim 7 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 7 recites that the promoter is a modified promoter obtained by inserting two specific elements into a promoter functioning in *Aspergillus*. However, the claim on which it depends, claim 4, recites that the promoter is the promoter associated with the gene encoding  $\alpha$ -amylase, glucoamylase, or  $\alpha$ -glucosidase (assuming this interpretation of claim 4, see above). Therefore, claim 7 fails to further limit the subject matter of the previous claim since it encompasses embodiments not included in the claim on which it depends. The test for a proper dependent claim is whether the dependent claim includes every limitation of the parent claim. A proper dependent claim shall not be

conceivably infringed by anything which would not also infringe on the basic claim on which it depends.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

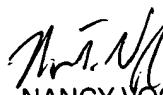
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nancy T. Vogel whose telephone number is (571) 272-0780. The examiner can normally be reached on 6:30 - 3:00, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Irem Yucel, Ph.D. can be reached on (571) 272-0781. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NV  
3/5/07



NANCY VOGEL  
PRIMARY EXAMINER